

REMARKS

Amendments to the claims

Claims 1-16 and 20-29 are pending in the application. New claims 22-29 are added to the application by this amendment. "Use" claims 17-19 are canceled. Claims 2, 6, 11, 20 and 21 are amended to dependent form to provide for fewer than 5 independent claims. Dependency of claims 10 and 16 are amended to adjust the number of claims overall.

No new matter is being added to the application as filed. Support for new claim 22 may be found in Table 1, page 24, of the specification (PG01037). Support for new claims 24 and 29 may also be found in Table 1, page 24, of the specification (PG01030). Support for new claim 23 may be found in Formula (I), page 3, line 13 to page 4, line 7 of the specification. See also, page 7, line 23 of the specification. The compound of claim 23 is arrived at in Formula (I) when R₁ is indole; R₂ and R₃ are Cl; A is trans -CH=CH-; B is absent; m=1; and n=1.

Applicants note that indole at the R₁ position is identified as a preferred embodiment at page 4, line 23 of the specification. The position A being trans -CH=CH-; R₂ and R₃ being Cl; m=1; and n=1, are all identified as preferred embodiments of Formula (I) at page 8, lines 6-10 of the specification. See Formula (III) at page 8, line 10. New claims 25-28 are likewise supported.

The MPEP makes clear that the written description requirement of 35 U.S.C. §112 is satisfied when:

[A]n applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was 'ready for patenting' such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing

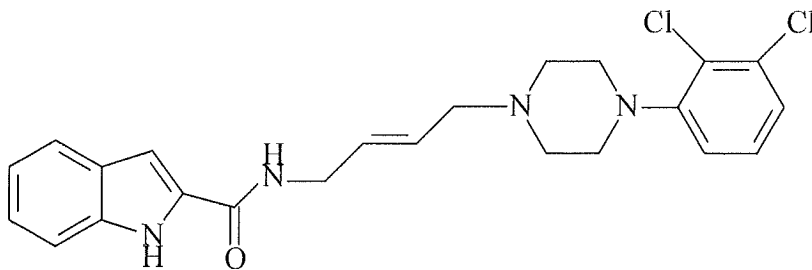
identifying characteristics sufficient to show that the applicant was in possession of the claimed invention.

MPEP §2163 (citations omitted) (emphasis added). Applicants submit that the specification clearly describes structural chemical formulas for each of the compounds of new claims 22-28. Applicants were therefore in possession of each of the claimed compounds as of the filing date of the application. Applicants also note that the compounds of claims 22-29 can be prepared by the procedure described at page 16, line 24 to page 17, line 9 of the specification. Accordingly, no new matter is added, and entry of this amendment is respectfully requested.

Response to restriction

The Examiner has required restriction among eighteen different groups of claims; designating groups first by different methods of use claimed, and then by particular species of compound employed in the use. Applicants submit that the restriction requirement as presently stated is improper and based upon incorrectly characterized facts.

Nevertheless, in the interest of compliance with rules of practice and to avoid abandonment of the present application, Applicants elect, with traverse, the claims of **Group VI, claims 1-4, 7, 11-13 and 19-21** for examination. Furthermore, as a particular species for examination, Applicants elect



(E)-N-(4-(4-(2,3-dichlorophenyl)piperazin-1-yl)but-2-enyl)-1*H*-indole-2-carboxamide, for initial examination. Applicants suppose that, should claims directed to this compound be found allowable over the prior art, the Examiner will proceed to examine additional species with an eye toward determining if a generic claim is allowable.

Claims 1-4, 7, 11-13, 20, 21, 23, 24, and 29 read upon the elected species.

Applicants **traverse** the restriction requirement as follows:

First, the present claims are restricted within a Markush group of structures, the Examiner asserting that the claims do not recite any common core structure and that the encompassed compounds do not have any common utility. Neither is a correct assertion. The common core structure of the compounds lies in the structure of the moiety linking the R₁ group to the phenyl group substituted by R₂ and R₃. This “rigid spacer” moiety confers upon the claimed compounds an excellent selectivity in binding of D3 dopamine receptors preferentially over D2 dopamine receptors, as explained in the specification at, e.g. page 14, lines 16-24, Table 2 at page 25. Thus, the Examiner’s reasons for restricting the claims among different compounds is recited in a single claim are baseless.

Second, the present application is filed as the national stage of a PCT application. As such, the Examiner must consider that the claims are all unified by a “special technical feature” providing patentability over the prior art. The Examiner asserts that such is not the case, presenting an excerpt from a search report and arguing that the number of references returned with the broad generic structure used for the search is evidence of lack of such a special technical feature.

Applicants submit that the Examiner has not yet met his burden of proof to establish lack of unity of the present claims. The Examiner has not presented any reference that establishes that the compounds recited in the present claims are not novel. There is no reference provided in the present Office Action that is demonstrated to disclose one or more of the compounds encompassed by the pending claims and that was published prior to the filing date of the present application. Accordingly, the Examiner presently has no basis for asserting lack of unity of invention under Rule 13.1 and the instant restriction requirement must be withdrawn.

Applicants submit that the proper approach to examination of the present application is by election of species practice. Applicants have elected a species for initial examination, and all of the claims presently pending should be examined with respect to the elected species, followed by examination of further species to determine allowability of generic claims should the elected species be found patentable over the prior art.

Withdrawal of the present restriction requirement, and undertaking of proper examination under election of species practice are respectfully requested. Favorable action on the merits of the application is requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell, Ph.D. (Reg. No. 36,623) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: February 27, 2008

Respectfully submitted,

By 
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